UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
BLACKWELL, JAMES H

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DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This office action is in response to Response B received 07/08/04.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Independent claim 1 and its dependent claims 2-12 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter. Independent Claim 1 is a computer program per se, and is not tangibly embodied on a computer readable medium. Claims 2-12 are also non statutory as they fail to correct the problem with Claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, and 13-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Safonov et al. (hereinafter Safonov, "Towards Web Macros: a Model and a Prototype System for Automating Common Tasks on the Web", Univ. of Minnesota, Copyright 06/03/1999).

In regard to independent Claim 1, Safonov teaches a recorder component that parses the HTTP request and replies and writes navigation actions to the interaction

database (p. 9; compare with Claim 1, *"A software application for creating and executing an automated Web browser navigation and task automation sequence comprising: a session recording module for recording user Web navigation and interaction activity associated with a manual navigation and interaction sequence"*). Safonov also teaches a script generator then reads interaction data from the database and attempts to generate a WebL script that will, when executed, retrieve the desired document (p. 9; compare with Claim 1, *"... a file creation module for converting data of a manual session into data comprising an executable sequence of instructions for conducting an automated navigation and task automation sequence"*). Safonov does not explicitly teach *an application-program-interface module for integrating a functional capability with the automated navigation and task sequence, characterized in that a completely automated, browser-navigation and task sequence, including one or both of auto-registration or secure login if required, is performed by the browser application enabled through execution of the executable instruction sequence created from the recorded parameters of the manual navigation and task sequence.* However, Safonov does teach that the macros are written as scripts using a scripting language called WebL as well as a WebL interpreter to run the scripts. It would have been obvious to one of ordinary skill in the art at the time of invention to use the WebL scripting language as an API providing the benefit of a means for processing documents on the World Wide Web.

In regard to dependent Claims 2 and 3, Safonov teaches Web Macros which are programs that emulate user interaction with the Web (p. 4). By definition, the Web is a

part of the Internet designed to allow easier navigation of the network through the use of graphical user interfaces and hypertext links between different addresses. Compare to Claim 2, *"... the automated sequence is executed to run on a data-packet-network"* and Claim 3, *"... the data-packet-network is the Internet network"*).

In regard to dependent Claim 4, Safonov does not *teach the file-creation module includes a function for creating an executable icon for launching the automated sequence*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to create an executable icon because it is common practice in a graphical user interface environment to identify applications with an icon providing the benefit of easier launching of applications.

In regard to independent Claim 13, Safonov teaches Web Macros that are programs that emulate user interaction with the Web. They can navigate on the Web, are authored implicitly by observing user actions, and are validated against results retrieved by the user (p. 4; compare to Claim 13, *"A method for creating an executable instruction file for performing an automated navigation and task automation sequence on a data-packet-network using a browser application comprising steps of:"*). Safonov also teaches that a user would navigate to a special URL with a browser and enter the name of the new macro. A database contains the information recorded during the navigation session (infers that there must be start and stop recording functions). The script generator then reads interaction data from the database and attempts to generate a WebL [KM98] script that will, when executed, retrieve the desired document (p. 9; compare to Claim 13, *"... (a) invoking a browser*

application and connecting to the network; (b) invoking and activating a session-recording module for recording a manual navigation and user Web activity sequence; (c) performing a desired manual navigation and Web activity sequence, including one or both of Website auto-registration or login, the sequence recorded by the recording function; (d) activating a stop-record function to define the end of the manual sequence; and (e) converting the recorded manual sequence into executable instruction enabling the automated sequence, the conversion performed by software").

In regard to dependent Claim 14, Safonov teaches Web Macros which are programs that emulate user interaction with the Web (p. 4). By definition, the Web is a part of the Internet designed to allow easier navigation of the network through the use of graphical user interfaces and hypertext links between different addresses. Compare to Claim 14, *"... in step (a), the data-packet-network is the Internet network"*).

In regard to dependent Claim 15, Safonov teaches that a user would navigate to a special URL with a browser and enter the name of the new macro. A database contains the information recorded during the navigation session (infers that there must be start and stop recording functions). The script generator then reads interaction data from the database and attempts to generate a WebL[KM98] script that will, when executed, retrieve the desired document (p. 9; compare to Claim 15, *"... in step (e) the software converting data from the recorded session into the executable instruction prompts a user to name the executable instruction and to name an icon created and associated with instruction"*). Safonov does not explicitly teach

that an icon is named. However, it would have been obvious to one of ordinary skill in

the art at the time of invention to assume that, especially in a GUI-based operating

system, that an icon either would have been generated to represent the file created, or

that one could have been generated by commands to the operating system providing

the benefit of easier launching of an application.

In regard to dependent Claim 16, Safonov teaches that Web macros could be

written explicitly by the user (p. 5). Safonov also teaches that the process of script

creation and validation is interactive (p. 9). Both of these operations suggest that one

could edit either the raw recorded information, or the macro to add or remove

information. Therefore, it would have been obvious to one of ordinary skill in the art at

the time of invention to add services, including proxy services to the executable

instruction providing the benefit of enhancing a user's automated navigation to hard-to-

reach web pages.

Claims 5-12, and 17-21 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Safonov in view of Anupam et al. (hereinafter Anupam, "Automating

Web Navigation with the WebVCR", Bell Labs, Copyright 03/01/2000).

In regard to dependent Claim 5, Safonov fails to teach that *the executable*

sequence of instructions are XML instructions. However, Anupam teaches smart

bookmarks which are shortcuts to Web content that require multiple browsing steps to

be retrieved---they may be saved in bookmark lists, or mailed to others like any other

bookmark (p. 2, 2nd paragraph). Fig. 7 contains a listing of a smart bookmark containing

the steps used to login at http://www.travelocity.com. Though not called XML by

Anupam, the smart bookmark does contain open and close tags and a hierarchical

structure that are similar to XML (p. 13). Therefore, it would have been obvious to one

of ordinary skill in the art at the time of invention to combine the teachings of Safonov

and Anupam providing the benefit of a standardized, structured, and hierarchical

language for describing a web navigation session.

In regard to dependent Claim 6, Safonov teaches that Web Macros must emulate

user actions: retrieve documents, and fill out and submit forms. Web Macros must be

able to extract hyperlinks from the HTML content and follow them (p. 5, 1st paragraph;

compare with Claim 6, *"... **the automated sequence enables automation of one or**

more of form-application, data-downloading, media-interaction, data-searching,

and hyper-linking").

In regard to dependent Claims 7 and 8, Safonov does not specifically teach that

the application is implemented as a browser plug-in containing a user-configuration tool

or as *a standalone program containing a user-configuration tool.* However, Anupam

teaches that WebVCR can be implemented as either a client-based or a server-based

process. In the case of a client-based process, WebVCR exists as a downloadable

Java applet used in conjunction with the user's browser to record and replay smart

bookmarks. The applet can be installed on the end-user's desktop, or downloaded

whenever required from a web site hosting the applet (pp. 5-6). It would have been

obvious to one of ordinary skill in the art at the time of invention to combine the

teachings of Safonov and Anupam providing the benefit of client-based, automated web navigation.

In regard to dependent Claim 9, Safonov teaches that given a suitable programming language, Web Macros could be written explicitly by the user (p. 5; compare with Claim 9, *"... the automated sequence is created as a result of manual user programming as an alternative option to recording a manual sequence"*).

In regard to dependent Claim 10, Safonov teaches a prototype system for creation, validation, and playback of scripts implementing a subset of functionality planned for Web Macros. The Web Macros prototype is designed as a HTTP proxy that sits between the Web and the Browser (pp. 8-9; compare to Claim 10, *"... the automated sequence includes an embedded request to one or more proxy services to be performed by a service provider operating on and accessible via the Internet network"*).

In regard to dependent Claims 11 and 12, Safonov does not specifically teach that *the embedded request is automatically sent to the service provider during execution and performance of the automated sequence* or that *the embedded request is received by virtue of an opened communication channel established between communicating navigation applications while the sending application is performing the automated sequence*. However, Anupam teaches that many sites offer affiliate programs, where they give third-party sites commissions from sales originated in those sites (see e.g., [2]). For instance, currently, a recipe site can put a link to a merchant site selling ingredients used in the recipe or to a product on that site which is needed in the recipe.

In the latter case, the user clicks on the product link and then makes a second click on

the resulting page at the merchant site to add the item to the shopping cart. However,

affiliate programs cannot make it really simple to order all the items in the recipe unless

the merchant site has already produced such a bundle. With WebVCR, staff of the

affiliate programs can produce a smart bookmark that will load a user's shopping cart

with exactly the right items for the recipe from the merchant's site (p. 10, 3rd paragraph).

The point is, that during recording, such third party advertisements would be recorded

and during replay would again present themselves to the user. This interchange would

take place over an opened communication channel established between communicating

navigation applications (browser and web server communicating over a network such as

the Internet). Therefore, it would have been obvious to one of ordinary skill in the art at

the time of invention to combine the teachings of Safonov and Anupam providing the

benefit of improving merchant sales.

In regard to dependent Claim 17, Safonov does not specifically teach that *the*

executable instruction is an XML template. However, Anupam teaches smart

bookmarks which are shortcuts to Web content that require multiple browsing steps to

be retrieved---they may be saved in bookmark lists, or mailed to others like any other

bookmark (p. 2, 2nd paragraph). Figure 7, shows the listing of a smart bookmark

containing the steps used to login at http://www.travelocity.com. Though not called XML

by Anupam, the smart bookmark contains open and close tags and a hierarchical

structure that are similar to XML (p. 13). Therefore, it would have been obvious to one

of ordinary skill in the art at the time of invention to combine the teachings of Safonov

and Anupam providing the benefit of a standardized, structured, and hierarchical

language for describing a web navigation session.

In regard to dependent Claims 18 and 19, Safonov teaches, with reference to his

second scenario, that Web Macros must be available to a user different from the one

who authored them. Two types of user-specific information need to be factored out:

Private information, such as name, address, and credit card number. These

parameters should never be left unchanged when a macro is passed to another user.

They must be substituted with data coming from the recipient user's profile; if these are

not available, the system would prompt the user for relevant data. Non-private

information. Examples of this are home airport for air travel reservations; while this type

of data can be left unchanged when a macro is passed to another user, intelligently

substituting it can increase the usability of Web Macros (p.6; compare to Claim 18, *"...

the executable instruction contains data personal to the user"* and Claim 19, *"...

the personal data includes one or a combination of user names, passwords,

credit card numbers, user location information, and Social Security information"*).

In regard to dependent Claim 20, Safonov does not specifically teach that *the

personal data remains encrypted until use.* However, Anupam teaches that there are

different modes for storing user-specified information in smart bookmarks. For instance,

the user is able to specify that password fields (e.g., Figure 1(b)) are either prompted for

when needed during replay, or are stored encrypted in the smart bookmark, whereas

fields like the origin and destination of flight (Figure 1(c)) can often be stored in plain

text. Accordingly, each attribute has the one of the following properties to guide the

WebVCR during playback: prompt (ask the user for the attribute value); stored (use the

value that is stored in plain text); encrypted (use the value that is stored encrypted; the

encryption key can be entered once for each WebVCR session) (p. 12, Sec 4.2;

compare to Claim 20, *"... the personal data remains encrypted until use"*). It would

have been obvious to one of ordinary skill in the art at the time of invention to combine

the teachings of Safonov and Anupam providing the benefit of safeguarding personal

information from view by others.

In regard to dependent Claim 21, Safonov does not specifically teach that *the*

personal data is stored in a secure location and accessed by virtue of a pointer to the

information, the pointer embedded in the instruction file. However, it would have been

obvious to one of ordinary skill in the art at the time of invention to store encrypted

information separate from the document providing the benefit of having prevented

unauthorized use of actual encrypted data.

Response to Arguments

Applicant's arguments filed 07/08/04 have been fully considered but they are not

persuasive.

Applicant argues that Safonov fails to teach *user auto-registration and/or login is*

enabled by an instance of software adapted to physically navigate to a target Web site

on behalf of the user, and register the user to the target site or service. The Examiner

disagrees. There are numerous instances in Safonov that make it obvious to one of

ordinary skill in the art at the time of invention that auto-logins are recorded and are

executed when Web macros are invoked. Safonov gives numerous examples (p. 1,

Intro., 1st paragraph; p. 2, Scenario 1, item 1; p. 6, Substitutability of personal

information bullet 1;p. 9, 4th paragraph) of instances where not only having a scripting or

macro would have been useful, but in many of those instances, as is commonly known,

would have required some sort of user identification and/or password to be used as part

of the automated transaction process. Safonov teaches in Scenario One: Author

Search in a Bibliography Database, a series of steps to access and use the Ovid

bibliography search engine that would need to be accommodated by a Web Macro.

Step 1 has the user enter the X.500 username and password, needed to validate him or

her as a University affiliate to gain access to the Ovid database. This clearly shows

what applicant argues Safonov fails to teach, namely that "a login is enabled by an

instance of software adapted to physically navigate to a target Web site on behalf of the

user, and register the user to the target site or service".

Additionally, applicant argues that the teaching of Safonov allows for *creating

only simple macros for enabling the user to automatically navigate back to the web site

and retrieve a document, or fill out and submit a form*. The Examiner disagrees. In light

of the example given above with respect to Scenario One, applicant would argue that

performing auto-login is a non-trivial exercise for an automated sequence such as a

macro to perform. Examiner argues that the teaching of Safonov fulfills applicant's

limitation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James H Blackwell whose telephone number is 571-

272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
11/26/04

SANJIV SHAH
PRIMARY EXAMINER